

REMARKS

As an initial matter, despite the Examiner contention that “Applicant’s arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection” (*Response to Arguments* section 6), Applicant believes that the Examiner is re-applying the same grounds for rejection and, therefore, Applicant’s previous remarks remain applicable. By amending the claims and specification, Applicant is not acquiescing to the Examiner’s rejections.

Claims 1-6, 8 and 20-24 stand rejected under § 103(a) as being obvious over U.S. Patent No. 5,442,500 to Hidano et al. (hereinafter referred to as "Hidano") in view of U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri"). Claims 9-19, 25 and 26 stand rejected under § 103(a) as being obvious over Hidano in view of Dimitri and U.S. Patent No. 5,128,912 to Hug et al. (hereinafter referred to as "Hug"). Claims 7 is allowable subject matter. Claims 1 and 4 have been cancelled without prejudice. New claims 27 and 28 are presented for examination.

Rejections Under 35 U.S.C. § 103

Claim 1 stands rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri.

Claim 1 has been canceled without prejudice. Applicant may pursue the subject matter of the canceled claim in this or other related applications. New claim 27 is presented in place of claim 1 which recites, “a first library assembly having a first frame and a second library assembly having a second frame; said first frame comprising a first side surface that comprises a first opening through a first portion of said first side surface; said second frame comprising a second side surface that comprises a second opening through a second portion of said second side surface; said first and second openings are adapted to form a passageway between said first and said second library assemblies when said first and said second surfaces are substantially adjacent and aligned; and a magazine transport device for moving a data cartridge magazine within said first frame, through said passageway, and within said second frame.” Nowhere does Hidano disclose a first

library assembly having a first frame having a first side surface wherein the first side surface has a first opening that is through a portion of the first side surface. Nowhere does Hidano disclose a second library assembly having a second frame having a second side surface wherein the second side surface has a second opening that is through a portion of the second side surface. Nowhere does Hidano disclose, teach or suggest first and second surfaces aligned and adjacent so that the openings form a passageway. Rather, Hidano shows a first cartridge rack 2a (left), which the Examiner analogizes to Applicant's first frame, and a second cartridge rack 2a (right), which the Examiner analogizes to Applicant's second frame. The cartridge racks 2a do not have a surface that has an opening in a portion of the surface and therefore cannot be aligned and adjacent to form a passageway through the cartridge racks for a magazine to pass through. The combination of Dimitri still fails to make up for the deficiencies of Hidano because neither Dimitri nor Hidano, alone or in combination, teach or suggest all of the elements of Applicant's claimed invention. Because there is not a bona fide showing of prima facie obviousness, Applicant respectfully submits that claim 27 is allowable over Hidano in view of Dimitri.

Claims 2-6, 8 and 20-24 stand rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri.

Dependent claim 4 has been canceled without prejudice, obviating the rejection. Applicant may pursue the subject matter of the canceled claim in this or other related applications.

Dependent claims 2-6 and 8 depend directly or indirectly from independent claim 27 which, as discussed above, is patentably distinguishable over Hidano in view of Dimitri.

Dependent claims 20 depends directly from independent claim 27 which, as discussed above, is patentably distinguishable over Hidano in view of Dimitri. The combination of Dimitri and Hidano still does not teach or suggest every element recited by Applicant's independent claim 27, and therefore, cannot render obvious dependent claim 20. In addition, Applicant notes that claim 20 recites "said first library assembly is

capable of functioning as said magazine-based data cartridge library without said second library assembly.” As the Examiner states, “Hidano et al shows that the first portion [left side 2a] is capable of functioning as a magazine-based cartridge library without the second portion [right side 2a].” Applicant respectfully disagrees that Hidano’s first portion 2a [the left rack 2a] in itself (alone) can function as a library assembly let alone a magazine based library. Because there is not a bona fide showing of prima facie obviousness, Applicant respectfully submits that claim 20 is allowable over Hidano in view of Dimitri for this additional reason.

Applicant reiterates from the previous responses of March 13, 2006, August 14, 2006 and the Pre-Appeal Request for Review of September 14, 2006 that the Examiner not only been has persistently silent to Applicant’s remarks and arguments but has failed to substantiate the requisite prima facie case of obviousness because the cited references do not, neither alone nor in combination, at least teach or suggest all of the features of the present embodiments as recited by independent claim 21, “said cabinet comprising a first side surface that is readily alterable to form a first passageway extending through a portion of said first side surface... a magazine-based data cartridge library add-on comprising: an add-on cabinet; wherein said add-on cabinet comprising a second side surface that is either readily alterable to form or already comprises a second passageway extending through a portion of said second side surface.” Nowhere does Hidano or Dimitri, at the least, teach or suggest a first or second side surface that is alterable to form a first passageway extending through a portion of said first side surface, hence, the combination of Dimitri and Hidano does not teach or suggest every element recited by Applicant’s independent claim 21. Furthermore, the Examiner has failed to express any motivation to combine Hidano and Dimitri as a basis for the rejection of independent claim 21, but rather, simply states “the above constructed Hidano et al and Dimitri’s device includes a method for making a magazine-based data cartridge library...” In the absence of reliable evidence of motivation, the Examiner’s statement that Hidano and Dimitri’s device includes a method for making Applicant’s claimed invention is not sufficient to substantiate the motivation or suggestion required in order to establish a

bona fide prima facie case of obviousness. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. vs. VSI Int'l Inc.*, 50 USDPQ2d 1161 (Fed. Cir. 1999); MPEP 2143.01.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. In this case the Examiner has provided no evidence whatsoever that the cited references consider the combination to be desirable. Because there is not a bona fide showing of prima facie obviousness, Applicant respectfully submits that claim 21 is allowable over Hidano in view of Dimitri.

Dependent claims 22-24 depend directly or indirectly from independent claim 21 which, as discussed above, is patentably distinguishable over Hidano in view of Dimitri. The combination of Dimitri and Hidano still does not teach or suggest every element recited by Applicant's independent claim 21. Applicant thus respectfully submits that claims 22-24 are allowable.

Claims 9-19, 25 and 26 stand rejected under § 103(a) as being unpatentable over Hidano in view of Dimitri as applied to claim 1 and further in view of Hug.

Dependent claim 9 depends directly from independent claim 27, which, as discussed above, is patentably distinguishable over Hidano in view of Dimitri and furthermore, Hug fails to make up for the deficiencies of the combination of Hidano and Dimitri.

Claim 9 recites, "said magazine transport device comprises: a first magazine transport device for moving said data cartridge magazine within said first frame; and a second magazine transport device for moving said data cartridge magazine within said second frame and within a first space that is within said first frame." The Examiner asserts that Hug shows "a transport device in Fig. 1 includes: a first transport device 26 for moving a data cartridge within the first frame 12, and a second magazine transport device 28 for moving a data cartridge within the second frame 14 and within a first space that is within the first frame 12." The Examiner analogizes Applicant's first and second

frames with Hug's arrangement 12 and 14. As with Hidano and Dimitri, Hug does not teach or suggest a first magazine transport device for moving a data cartridge magazine within a first frame, rather Hug only shows a first carriage assembly 26 and a second carriage assembly 28 capable of moving disc drives and discs strictly to and from storage compartments of the arrangements 12 and 14 through "front open ends" (column 3, line 45). Even assuming, *arguendo*, that the Examiner's combination of Hidano and Dimitri and Hug is proper, and assuming that the Examiner's contention regarding the combined disclosure of Hidano and Dimitri and Hug is accurate, the proffered combination still fails to teach or suggest each element of independent claim 27, such as a magazine transport device for moving a data cartridge magazine within a first frame and second frame that defines a first side surface and second side surface, respectively, in addition to a passageway that extends through openings in respective portions of the first or second side surfaces when substantially aligned and adjacent, let alone a magazine transport device that can move a data cartridge magazine through a passageway, and thus cannot render dependent claim 9 obvious. Furthermore, there is no motivation to combine the references by one skilled in the art to adapt Hug's configuration to Hidano's apparatus and Dimitri's magazine transport because doing so would defeat the purpose of key features of Hidano's apparatus. Because there is no bona fide showing of prima facie obviousness for claim 9, Applicant respectfully submits that claim 9 is allowable over Hidano in view of Dimitri and in view of Hug.

Dependent claims 10 and 11 depend directly from dependent claim 9 which, as discussed above, are distinguishable over Hidano in view of Dimitri and in view of Hug. Applicant thus respectfully submits that claims 10 and 11 are allowable.

Dependent claims 12-19 depend directly or indirectly from independent claim 27, which, as discussed above, is patentably distinguishable over Hidano in view of Dimitri, furthermore, Hug fails to make up for the deficiencies of the combination of Hidano and Dimitri.

Claim 12 recites, "said magazine transport device comprises: a first magazine transport device for moving said data cartridge magazine within said first frame; a second

magazine transport device for moving said data cartridge magazine within said second frame; and said third magazine transport device for moving said data cartridge magazine through said passageway.”

The Examiner analogizes Applicant’s first and second frames with Hug’s arrangement 12 and 14. As with Hidano and Dimitri, Hug does not teach or suggest a first magazine transport device for moving a data cartridge magazine within a first frame, rather Hug only shows a first carriage assembly 26 and a second carriage assembly 28 capable of moving disc drives and discs strictly to and from storage compartments of the arrangements 12 and 14 through “front open ends” (column 3, line 45). Furthermore, the Examiner admits that Hug is directed to only a first and second transport device 26 and 28, respectively, that do not even function in any equivalence to Applicant’s claimed first, second and third transport devices. Even assuming, *arguendo*, that the Examiner’s combination of Hidano and Dimitri and Hug is proper, and assuming that the Examiner’s contention regarding the combined disclosure of Hidano and Dimitri and Hug is accurate, the proffered combination still fails to teach or suggest each element of independent claim 27, such as a magazine transport device for moving a data cartridge magazine within a first frame and second frame that defines a first side surface and second side surface, respectively, in addition to a passageway that extends through openings in respective portions of the first or second side surfaces when substantially aligned and adjacent, let alone a magazine transport device that can move a data cartridge magazine through a passageway, and thus cannot render dependent claim 12 obvious. Furthermore, there is no motivation to combine the references by one skilled in the art to adapt Hug’s configuration to Hidano’s apparatus and Dimitri’s magazine transport because doing so would defeat the purpose of key features of Hidano’s apparatus. The Examiner has misapprehended the purpose of Applicant’s claimed invention by asserting that “The improved two transport devices system should be able to overcome these problems... In such constructed device, three transport devices will ball be able to transport magazines.” The term “should be” amounts to nothing more than a guess and certainly is in fact not a bona fide showing of prima facie obviousness for claim 12. Applicant, therefore,

respectfully submits that claim 12 is allowable over Hidano in view of Dimitri and in view of Hug.

Dependent claims 13-19 depend directly or indirectly from claim 12 which as discussed above are patentably distinguishable over Hidano in view of Dimitri and in view of Hug because the references alone or in combination, fail to teach or suggest each element of claim 12 and therefore claims 13-19. Hence, Applicant respectfully submits that claims 13-19 are allowable over Hidano in view of Dimitri and in view of Hug.

Dependent claims 25 and 26 depend directly or indirectly from independent claim 21. Claims 25 and 26, as previously discussed in the responses of March 13, 2006, August 14, 2006 and the Pre-Appeal Request for Review of September 14, 2006, are patentably distinguishable over Hidano in view of Dimitri in view of Hug because nowhere do any of the references disclose, teach or suggest features such as a first and second side surface of a library and add-on alterable to form a first and second passageway that extends through a portion of the relative side surfaces or a magazine transport device, or the equivalent thereof, located within an add-on cabinet, let alone moving a data cartridge magazine within an add-on cabinet. Furthermore, there has been no requisite explanation of motivation to combine, and hence, no bona fide showing of prima facie obviousness. Therefore, Applicant respectfully submits that claims 25 and 26 are allowable over Hidano in view of Dimitri and further in view of Hug.

New Claims Presented Herein

New independent claim 27 features a magazine-based data cartridge library with "a first library assembly having a first frame and a second library assembly having a second frame; said first frame comprising a first side surface that comprises a first opening through a first portion of said first side surface; said second frame comprising a second side surface that comprises a second opening through a second portion of said second side surface; said first and second openings are adapted to form a passageway between said first and said second library assemblies when said first and said second surfaces are substantially adjacent and aligned; and a magazine transport device for

moving a data cartridge magazine within said first frame, through said passageway, and within said second frame.” These features are shown in FIG. 7A, 43A, 43B, 44A, 44B, 45A, 45B, 45C and 45D and are recited in at least the specification paragraph [0111] and [0278] – [0280] and were recited in both claims 1 and 21 and hence do not add new matter. None of the prior art of record, including Hidano and Dimitri, appears to describe, teach, or suggest the invention of claim 27 as discussed supra at ppgs. 11-12, and thus Applicant submits that this claim is allowable.

New independent claim 28 is directed to a magazine-based data cartridge library and features “a first library assembly and a second library assembly; said first library assembly comprising a first frame having a first side, said first side covered by a first wall defined by at least a first and second plate, a first passageway extending through a first portion of said first side when said first plate is removed; said second library assembly comprising a second frame having a second side, said second side covered by a second wall defined by at least a third and fourth plate, a second passageway extending through a second portion of said second side when said third plate is removed; a magazine transport device for moving a data cartridge magazine within said first frame, moving said data cartridge magazine through said first and second passageways, and moving said data cartridge magazine within said second frame.” These features are shown in FIG. 7A, 43A, 43B, 44A, 44B, 45A, 45B, 45C and 45D and are recited in at least the specification paragraph [0111] and [0278] – [0280] and hence no new matter is added. This claim was drafted under the instructions of Examiner Chen in a telephone interview on September 26, 2006. This claim was agreed to be deemed acceptable if made of record, following Examiner Chen’s review confirming that the content in the claim conforms to what was discussed. This claim was made of record on September 27, 2006 and hence is believed allowable over the prior art of record.

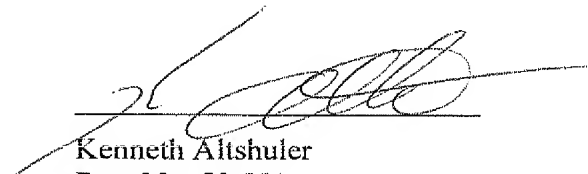
* * *

Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any additional necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-3010.

Respectfully submitted,

Dated: 1/22/07


Kenneth Altshuler
Reg. No. 50,551

Correspondence Address
HISCOCK & BARCLAY, LLP
200 HSBC Plaza
100 Chestnut Street
Rochester, New York 14604-2404
Telephone: (303) 449-6444 x1251
Telephone: (585) 295-4497
Facsimile: (585) 295-8453

Customer No.: 67,070

PATENT TRADEMARK OFFICE